

DOCKET NO.: 273944US28PCT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Yukio TSURUOKA, et al.

SERIAL NO: 10/539,135

GROUP: 2614

FILED: June 16, 2005

EXAMINER:

FOR: ADDRESS NOTIFICATION DEVICE AND METHOD

LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a European Office Action for the Examiner's consideration. The reference(s) cited therein have been previously filed on August 9, 2007.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink that reads "Joseph Scafetta Jr." It is written in cursive script and appears to be signed over a horizontal line.

James J. Kulbaski
Registration No. 34,648
Joseph Scafetta, Jr.
Registration No. 26,803

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 03/06)



EPA/EPO/OEB
D-80298 München
+49 89 2399-0
TX 523 656 epmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

Generaldirektion 2

European
Patent Office

Directorate General 2

Office européen
des brevets

Direction Générale 2

Hoffmann, Eckart
Patentanwalt,
Bahnhofstrasse 103
82166 Gräfelfing
ALLEMAGNE

EINGEGANGEN
Hoffmann · Gräfelfing

13. Sep. 2007
1. Oct. 2007
WV: 3. Jan. 2008
Frist: 10. Jan. 2008 Notiz

Telephone numbers: Branch at The Hague

Primary Examiner +31 70 340-2370
(substantive examination)

Formalities Officer / Assistant +31 70 340-0
(Formalities and other matters)



Application No. 04 772 453.9 - 1244	Ref. A5/70036 WO EP	Date 10.09.2007
Applicant NIPPON TELEGRAPH AND TELEPHONE CORPORATION		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Goya, Jesus
Primary Examiner
for the Examining Division

Enclosure(s): 5 page/s reasons (Form 2906)



Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date	10.09.2007	Blatt Sheet Feuille

1

Anmelde-Nr.: Application No.: 04 772 453.9
Demande n°:

The examination is being carried out on the **following application documents**:

Description, Pages

1-46 as originally filed

Claims, Numbers

1-14 as originally filed

Drawings, Sheets

1/18-18/18 as originally filed

- 1 The following documents are referred to in this communication; the numbering will be adhered to in the rest of the procedure:
 - D1: WO 99/57859 A (SIEMENS INF & COMM NETWORKS [US]) 11 November 1999
 - D2: US 2003/091167 A1 (HIRAI YOSHIYUKI [JP]) 15 May 2003
 - D3: "MAIL ADDRESS CHANGE NOTIFICATION" IBM TECHNICAL DISCLOSURE BULLETIN, IBM CORP. NEW YORK, US, vol. 36, no. 1, January 1993 (1993-01), pages 70-72, ISSN: 0018-8689
 - D4: DE 199 39 057 A1 (SIEMENS AG [DE]) 1 March 2001
- 2 The present application does not meet the requirements of Article 52(1) EPC because the subject-matter of the independent **claims 1 and 8** is not new in the sense of Article 54(1) and (2) EPC.



Beschied/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 10.09.2007	Blatt Sheet Feuille 2	Anmelde-Nr.: Application No.: 04 772 453.9 Demande n°:

2.1 Document D1 discloses in terms of **claim 1** an address notification device (abstract) comprising:

- a link information list storage part for storing link information list composed of link information including an own address, an address of a communicating party, and process information about processing of communication information to be communicated between said own address and said communicating party address (abstract; page 3, lines 25-34);
- link information select part for selecting link information to be changed (page 5, lines 19-35);
- a change information registration part for adding said link information selected by said link information select part with change information representing the content of the change (page 5, lines 19-35);
- a link change information sending part for sending link change information representing a change of said link information to a destination indicated by said communicating party address contained in said link information added with said change information (page 4, lines 10-19; page 5, lines 19-35); and
- a link information change part for changing said link information on the basis of said change information added thereto in response to response information sent from said communicating party in response to the sending thereto of said link change information (claim 1; page 5, lines 19-35).

Therefore, the subject-matter of claim 1 is not new (Article 54 (1) and (2) EPC).

2.2 **Claim 8** is a representation of apparatus claim 1 in terms of method. Document D1 discloses the apparatus of claim 1 and also the associated method (abstract; claim 1; figure 1). Consequently, the subject-matter of claim 8 is also not new in the sense of Article 54(1) and (2) EPC.

2.5 It is noted that the subject-matter of the independent claims 1 and 8 is also not novel over the disclosure of documents D2 (abstract; paragraphs [0005]-[0012], [0017], [0109]-[0110], [0153]-[0156]; [0167]-[0168]; figures 1, 4, 5, 34), D3 (whole document) or D4 (whole document).



Beschied/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 10.09.2007	Blatt Sheet Feuille 3	Anmelde-Nr.: Application No.: 04 772 453.9 Demande n°:

3 The following is noted regarding the dependent claims.

3.1 The additional features of the dependent **claims 2-3, 5-6, 9, 11, 13-14** are disclosed in the prior art document D1 (abstract; page 4, lines 10-19; page 5, lines 19-35). Consequently, these claims are not allowable due to lack of novelty, Article 54(1) and (2) EPC.

3.2 The additional features of **claims 4, 7, 10, 12** are considered implementation related design options (deleting information, the merging of identical information or the use of security keys) are obvious for the skilled person in the field of network design. Consequently, these claims are not allowable due to lack of inventive step, Article 56 EPC.

4 The present application does not meet the requirements of Article 84 EPC.

4.1 It is not clear in the last point of **claims 1** and 8 what the meaning of the following statement is: "... of said change information added thereto in response to response information sent from said communicating party in response to the sending thereto of said link change information". Clarification is required.

4.2 In relation to the previous point, in claim 8 it is made reference to "said address notification device of said communicating party". This expression is not clear because the term "said address notification device of said communication party" lacks an antecedent in the claim, and therefore it is not possible to know what the technical features associated with this attributes are. The claim is directed to an "address notification device", but it appears that this is not in the communicating party, and therefore the "address notification device of the communicating party" is not previously introduced in the claim and therefore lacks an antecedent.

4.3 It is noted that claim 8 is defined as a "method by an address notification device of claim 1". The applicant is requested to clarify this statement by, for example, "method performed by an address notification device of claim 1". The attention of the applicant is brought to the fact that, with such formulation of the claim, the scope of this method is limited to a device including all the features of claim 1.



Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 10.09.2007	Blatt Sheet Feuille 4	Anmelde-Nr.: Application No.: 04 772 453.9 Demande n°:

5 Applicant is requested to also attend to the following matters:

- 5.1 It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC. The applicant should also indicate the difference of the subject-matter of the new claim vis-à-vis the state of the art and the significance thereof.
- 5.2 New independent claims should be drafted taking account of Rule 29 (1) EPC according to which the features known from documents D1, D2, D3 and D4 should be put into the preamble. The applicant should also indicate in the letter of reply the difference of the subject-matter of the new claims vis-à-vis the state of the art (in particular document D1) and the significance thereof.
- 5.3 Reference signs in parentheses should be inserted in all the claims to increase their intelligibility, Rule 29 (7) EPC. This applies to both the preamble and the characterising portion (see the Guidelines C-III 4.11). Where a method claim makes reference to apparatus features, these should also be accompanied by the respective reference signs wherever appropriate.
- 5.4 When filing amended claims, the applicant should at the same time bring the description into conformity with the amended claims (Rule 27 (1) EPC).
- 5.5 To meet the requirements of Rule 27 (1) (b) EPC, the documents D1, D2, D3 and D4 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.
- 5.6 Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC). In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is requested to clearly identify the amendments, and to indicate the passages of the application as filed on which these amendments are based (Guidelines, E-II, 1).



Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 10.09.2007	Blatt Sheet Feuille 5	Anmelde-Nr.: Application No.: 04 772 453.9 Demande n°:

J. GOYA